

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10750804. Although the conflicting claims are not identical, they are not patentably distinct from each other because these differences are obvious variations of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 of the instant application and co-pending claim 1 both claims method of receiving facsimile in a multi-function printer device answering, playing monitoring and recording (i.e., generating) incoming and outgoing message

Claim 1 differs from co-pending claim 1 in the following way: claim1 of the instant application is broader than that of the copending application.

With respect to the difference co-pending claim 1, does not ceasing playing of outgoing message in response to facsimile tone, one ordinary skill in the art would have realized that employing ceasing playing of outgoing message in response to facsimile tone to provide flexibility of using the system, incase wherein cost is not a critical factor.

The limitation of claims 2-9 of the instant application and the limitation of co-pending application of claims 7-10 and 11 are considered identical, respectively based on the reason of obviousness on ceasing playing of outgoing message in response to facsimile tone given for claim 1 above.

With respect to claim 10, the limitation of claims 10-19 of the instant application and the limitation of co-pending application of claims 11-18 are considered identical, respectively based on the reason of obviousness on ceasing playing of outgoing message in response to facsimile tone given for claim 1 above.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEGUSSIE WORKU whose telephone number is (571)272-7472. The examiner can normally be reached on 9A-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Negussie Worku/

Examiner, Art Unit 2625